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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT

In the Matter of the Application of:
199 Wayne S. Davis
Serial No.: 08/014,911

Filed: February 8, 1993

For: ELECTRICAL CONNECTOR WITH PROTECTION FOR ELECTRICAL
CONTACTS

Examiner: K. Nguyen Group Art Unit 3202

Assistant Commissioner for Patents
Washington, DC 20231

I hereby certify that this correspondence is being
deposited with the United States Postal Service as first
class mail addressed to the Assistant Commissioner for
Patents, Washington, DC 20231 on July 15, 1995.

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REPLY BRIEF

Sir:

This is Appellant's Reply Brief in answer to the
Examiner's Answer mailed, July 11, 1995.

The Examiner's Answer, at page 6, lines 18-22, states:

"... [T]he broad language 'interposed' as recited
in claim 1 without setting forth specific
portions of the contacts does not limit that the
wiping surfaces can be positioned in between any
portions of the contacts and a front edge of the
circuit board."

In response, this statement lacks meaning. This
statement in the Examiner's Answer should be disregarded,
due its lack of meaning.

The Examiner's Answer, at page 7, lines 17-18,
contains a statement:

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"... [I]t is submitted that the important (sic) of EDS [ESD] protection was not originally emphasized by appellant prior to the brief."

In response, the Examiner's Answer appears to raise an objection because Appellant's Brief On Appeal refers to ESD protection by quoting directly from Appellant's specification. The specification existed in the record prior to the Brief. Further, Appellant's paper number 6, filed September 12, 1995, discloses that claim 3 teaches ESD protection for contacts. (It is noted that Claim 3 had been allowed; then the allowance was withdrawn, and the Claim was rejected for the first time, in Paper No. 5.)

The Examiner's Answer, at page 7, lines 19-22, states:

"... [A]s shown in figure 8 of Olsson, his contacts 50 are recessed from a front edge of the connector housing 10 and the shield 78.

Therefore, the connector housing of Olsson also provide (sic) for EDS [ESD] protection."

In response, a disclosure of contacts 50, as shown in Figure 8, would have been interpreted by one skilled to be consistent with Figs. 3, 4, 5, 6 and 7, all of which Figures, when taken together as a whole, show that the contacts 50 are not recessed from a front edge of the housing 10. ESD protection would not have been taught by the disclosure of Olsson to one skilled, since no description of ESD protection appears in the specification or in the multiple Figures when considered together as a whole. Figs. 3-8, when considered together as a whole, indicate with consistency of disclosure, that the rejection is based on an erroneous interpretation of Figure 8 of the reference.

The Examiner's Answer, at page 8, lines 19-22, states:

"... [I]t is respectfully submitted that there seem (sic) to be no significant advantage by

providing a wiping surface that is closer to the shield than the contacts."

In response, the claims are on appeal for reciting differences over the prior art, such differences being novel and unobvious to one skilled. The presence or absence of a significant advantage over the prior art is a secondary consideration for patentability, and is not needed when the appealed claims recite differences, over the prior art, that are novel and unobvious. Nevertheless, a factual basis for such an advantage appears in Appellant's specification, page 10, lines 7-15, that discloses:

"The engaged conductive shells 37, 38 discharge electrostatic voltages to ground before the contacts 4, 5 and the contact fingers 9 of the connectors 1 engage one another. The engaged conductive shells 37, 38 are engaged while the insulative wiping surfaces 61 are interposed between the contacts 4, 5 of the two connectors 1, and between the contact fingers 9 [of] the two connectors 1."

The presence of the insulative wiping surfaces 61, interposed between the contacts and the shell of the recited connector, does provide a significant advantage over the teachings of Asick et al. Asick et al. requires the contact surface 80 to extend to a front edge of a circuit board, thus being devoid of any advantage of providing ESD protection. In Buchter et al. no discussion of providing ESD protection appears. There would be no need to obtain ESD protection in Buchter et al. as modified by Asick et al, when no such protection is suggested by either of the references Buchter et al. or Asick et al. Accordingly, one skilled would not have combined Asick et al. with Buchter et al. in a manner further to achieve ESD protection. Such an achievement by one skilled would have

been beyond the scope of the combined teachings of Buchter et al. and Asick et al. The teachings of Asick et al. would be carried forward by one skilled, to modify Buchter et al. with a contact surface 80 extending to a front of a circuit board, as taught by Asick et al.

The Examiner's Answer, at page 8, lines 10-12, states:

"... [A]s shown in figure 4 of Roberts, the insulation portions 82 clearly [are] interposed between the contact ears 60 and front edge 22 of the connector housing."

In response, Fig. 4 of Roberts shows that insulation portions 82 are beside the contact ears 60, rather than being interposed between the contact ears 60 and a front edge of the connector. Because the same subject matter is shown in Figs. 4 and 9, Figure 9 clearly shows that the insulation is beside the contact ears 60, rather than, as recited in the claims on appeal, interposed between the contact ears 60 and the front edge of the connector.

The Examiner's Answer, at page 8, lines 12-15, states that the contact ears 60, of Roberts, are positioned a sufficient distance from the front edge of the connector to minimize ESD. Appellant's claims recite insulation, and not mere distance, between the contacts and the front edge of the connector. Thus, mere distance, as taught by the reference Roberts, would not have taught to one skilled the invention as claimed.

Respectfully submitted,

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